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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/945,006      | 08/31/2001  | J. Pat Evans         | 10368/24701         | 1607             |

24349 7590 03/28/2003

WILLIAM R. GUSTAVSON  
SUITE 1185  
9330 LBJ FRWY.  
DALLAS, TX 75243

EXAMINER

STASHICK, ANTHONY D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/945,006             | EVANS ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Anthony D Stashick     | 3728                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 18-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-17, drawn to an insole with an arch support, classified in class 36, subclass 145.
  - II. Claims 18-20 and 27-32, drawn to an insole with inserts in heel and forefoot with an arch support, classified in class 36, subclass 174.
  - III. Claims 21-26, drawn to an insole with an arch support and at least one shock absorber, classified in class 36, subclass 153.
  - IV. Claims 33-40, drawn to a layered sole with an insole, arch support and shock absorbers, classified in class 36, subclass 44.
  - V. Claim 41, drawn to the method of making a three-dimensional foot device, classified in class 12, subclass 142N.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II, III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as being used to support the arch of the user; Invention II has separate utility such as an insole with supports for the heel and forefoot of the user; Invention III has separate utility such as a shock absorber for the user's entire foot; and Invention IV has separate utility such as supporting the user's arch while absorbing shock throughout the rest of the foot. See MPEP § 806.05(d).
3. Inventions V and the other invention are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation,

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different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are an insole and the method of making a three-dimensional foot support.

4. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, the search required for one Group is not required for any other Group, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The above election is now made **Final**.

5. Applicant's election of Invention I in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Therefore, claims 18-41 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

#### ***Drawings***

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: reference number 74 as shown in Figure 3. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2-4 and 6-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Within the context of claims 2-4 and 6-17 the applicant uses portions of the human foot, i.e. first metatarsal head, third metatarsal head, Astragalus etc., to describe the positioning of portions of the claimed invention. Since these portions of the human foot differ in placement, size and shape on people who wear the same sized shoe, it is difficult to determine the metes and bounds of the claims. Also, claim 7 contains the limitation that the raised arch support portion is approximately 0.375 inches greater than a height dimension of the insole, but since the arch support portion is part of the insole, it is not clear how it can be higher than the insole.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-6, 8-11, 13-15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Schroer, Jr. et al. 5,282,326. Schroer, Jr. et al. '326 discloses all the limitations of the claims including the following: an insole 2 having a raised arch support portion (see Figure 5a, area 22) with the peripheral contour of the arch section generally conforming to the longitudinal arch and transverse arch of the plantar surface of a user's foot (see Figures 1 and 3); the peripheral contour is defined by a curve having a first endpoint located on a medial edge of the insole (see Figure 1) generally corresponding to a forward most medial point of the longitudinal arch; a second endpoint located

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rearward of the first endpoint on the medial edge of the insole (also Figure 1); the curve extends forwardly and laterally (Figure 1) from the first endpoint through a point generally corresponding to a midway point between second and third metatarsal heads of the foot and rearwardly along the medial edge of the fifth metatarsal head of the foot then rearwardly and medially to the second endpoint (see Figure 1); the curve extends across a point generally corresponding to a cuboid of the foot; the raised arch support portion forms part of the foot bed (see Figure 3); the raised arch support portion has a maximum height dimension substantially midway between a first metatarsal head and an Astragalus of the human foot (see Figure 3); the raised arch support portion has a maximum height dimension midway between a Tibialis Anticus of the human foot (see Figure 3); the insole has dimensions that generally correspond to a human foot of predetermined size; the insole is capable of supporting substantially all of the plantar surface of the human foot (see Figure 3); a surface layer 12 provided on the upper surface of the foot bed; the foot bed has a hind foot region and a forefoot region and is made of flexible material (see col. 5, line 49-col. 6, line 66).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroer, Jr. et al. 5,282,326. Schroer, Jr. et al. '326 discloses all the limitations of the claims as noted above. Although Schroer, Jr. et al. '326 does not specifically state the height of the arch support portion, it appears that it would have been a mere matter of design testing an evaluation to find what the average

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height is for the arch portion of a persons foot and use that height to be the support height of the arch support portion since this portion would be used to support the arch of the average user. With respect to claim 16, it is well known in the art of insole making to make the top layer of an insole out of a textile material to aid in giving comfort to wearing the shoe and to aid in wicking away perspiration.

### *Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

|                                 |                     |
|---------------------------------|---------------------|
| Allowed Files & Publication     | (703) 305-8322      |
| Assignment Branch               | (703) 308-9287      |
| Certificates of Correction      | (703) 305-8309      |
| Drawing Corrections/Draftsman   | (703) 305-8404/8335 |
| Fee Increase Questions          | (703) 305-5125      |
| Intellectual Property Questions | (703) 305-8217      |
| Petitions/Special Programs      | (703) 305-9282      |
| Terminal Disclaimers            | (703) 305-8408      |
| Informal Fax for 3728           | (703) 308-7769      |

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

|                        |   |
|------------------------|---|
| Information Help line  | 1-800-786-9199  |
| Internet PTO-Home Page | <a href="http://www.uspto.gov/">http://www.uspto.gov/</a> |



Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS  
March 21, 2003